

Remarks/Arguments

The foregoing amendments to the claims are of formal nature, and do not add new matter. Claims 119-126, 129-131 and 135-143 were pending in this application and were rejected on various grounds. Claims 119-123, 130-131 and 139-143 have been canceled without prejudice or disclaimer to pursue their subject matter in subsequent continuations or divisional applications. Claims 124-126 and 129 have been amended for clarity. Claim 135 has been amended to correct claim dependency. Rejections to the pending claims are respectfully traversed.

Priority

Applicants acknowledge the Examiner's comments and have amended the specification to correct priorities.

Further, Applicants submit that they rely on the homology of PRO1186 to "the black mamba venom protein" for patentable utility of the instant application. This homology was first disclosed in US Provisional Application 60/096,146, filed August 11, 1998, priority to which has been claimed in this application and is hereby enclosed for the Examiner's reference. Therefore, Applicants believe that they are entitled to a priority date of at least **August 11, 1998** for the instantly pending claims.

Claim Rejections – 35 U.S.C. § 102(f)

Claims 119-135, 137 are rejection under 35 U.S.C. §102(f) for allegedly not inventing the claimed subject matter. The Examiner asserts that "Applicants derived the invention from another and did not invent the subject matter sought to be patented. Purchase of the Incyte clone suffices to establish that one of ordinary skill in the art was able to make a polynucleotide comprising the nucleotide sequence of SEQ ID NO:370..."

Claims 119-123, 130-131 and 139-143 have been canceled without prejudice or disclaimer and hence the above rejection is moot with respect to these claims. Applicants strongly traverse this rejection to the remaining pending claims.

Arguments

Conception is the “formation in the mind of the inventor, of **a definite and permanent idea of the complete and operative invention**, as it is hereafter to be applied in practice.”

Hitzeman v. Rutter, 243 F.3d 1345, 58 USPQ2d 1161 (Fed. Cir. 2001) (emphasis added).

Applicants submit that they were the first to conceive the novel, “complete” DNA sequence encoding PRO1186. Applicants submit that in this instance, the prior art, the Incyte EST 3476792 sequence, only disclosed an incomplete DNA sequence with partial identity to the nucleotide sequence of SEQ ID NO: 370, disclosed and claimed in the present application.

In support, Applicants submit a declaration by Dr. William Wood, co-inventor and Director of the Bioinformatics Department at Genentech, Inc., who played a key role in identifying and characterizing nucleic acids encoding novel polypeptides discovered in Genentech's Secreted Protein Discovery Initiative project. Dr. Wood's Declaration explains that, while an Incyte EST sequence (EST 3476792) was used in identifying the coding sequence of PRO1186, the Incyte EST sequence did not code for the full-length PRO1186 polypeptide, since it truncated prematurely before the nucleotide encoding for the stop codon. This is evident from the alignment in Exhibit A, which is attached to and forms part of the Declaration. In other words, even if it had been known that the Incyte EST sequence was a coding sequence, as it was not, it would only have encoded for a truncated polypeptide, and not for the full-length PRO1186. Applicants submit that they used their own knowledge of the extracellular domain sequence of PRO1186 (ECD), clustering analysis, extension of DNA sequences and PCR-based cDNA library screening to obtain the full-length nucleic acid sequence encoding for the PRO1186 polypeptide, and designated the novel DNA as DNA60621.

Therefore, contrary to the Examiner's assertion, Incyte did not possess or reduce to practice a “complete” DNA sequence identical to the instantly claimed DNA of SEQ ID NO: 390 encoding for the PRO1186 polypeptide and therefore, the instant invention is not anticipated by the Incyte EST 3476792 sequence. Furthermore, contrary to the Examiner's assertion, one of skill in the art would not have been able to make a polynucleotide comprising the nucleotide sequence of SEQ ID NO: 370 or its encoding amino acid sequence of SEQ ID NO: 371 without first having to realize that EST 3476792 was part of a coding sequence, and having to extend this EST sequence, an act which would have required additional knowledge regarding the sequence to

be used for the extension, like prior knowledge of the PRO1186's extracellular domain, for instance. Such knowledge was not provided by Incyte (who did not disclose or reduce to practice the encoded polypeptide or the encoding nucleic acid) around the effective filing date of the instant application. Hence, Applicants submit that the instantly claimed subject matter could not have been derived from the Incyte EST sequence alone without significant work done by the Applicants that contributed towards "conception, completion and operation" of the invention. Therefore, Applicants respectfully request that this rejection under 35 U.S.C. §102(f) be withdrawn.

Claim Rejections - 35 U.S.C. § 112, first paragraph

Claims 135-143 are rejected under 35 U.S.C. §112, first paragraph, because the specification, while being enabling for a polypeptide encoding a polypeptide having at least 80% identity to a polypeptide comprising the amino acid sequence of SEQ ID NO: 371, etc. does not reasonably provide enablement for a polynucleotide encoding a polypeptide without regard to the functional activity of the encoded polypeptide.

In view of the cancellation of claims 119-123, 130-131 and 139-143 in this amendment, this rejection is moot with respect to these claims. Further, Claims 135-138 presently depend on claim 124 and therefore, are clearly enabled. Therefore, Applicants respectfully request that this rejection should be withdrawn.

Claim Rejections – 35 U.S.C. § 102(e)

Claims 119-123, 135-138 are rejected under 35 U.S.C. §102(e) as being anticipated by Sheppard (U.S. Patent 6,485,938- sequences first disclosed in U.S. provisional 60/165,905 filed Nov. 16, 1999).

In view of the cancellation of claims 119-123, 130-131 and 139-143 in this amendment, this rejection is moot with respect to these claims. In addition, as discussed under the 'Priority' section, Applicants believe that they are entitled to a priority date of at least **August 11, 1998** for the instantly pending claims, which predates that Sheppard reference. Therefore, Claims 135-138 presently depend on claim 124, which from the above discussions, is not anticipated. Accordingly, Sheppard is not prior art and therefore, this rejection should be withdrawn.

Double Patenting Rejection

(1) Claims 119-126, 129, 135-143 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-25 of copending Application No. 10/692,299. The Examiner says that "Although the conflicting claims are not identical, they are not patentably distinct from each other because SEQ ID NO: 371 of the present application is identical to SEQ ID NO: 2 of the copending application. SEQ ID NO: 370 of the present application is identical to SEQ ID NO: 1 of the copending application."

In view of the cancellation of claims 119-123, 130-131 and 139-143 in this amendment, this rejection directed to these claims are moot. Regarding the remaining claims, Applicants respectfully request that this rejection be held in abeyance until there is an indication of allowable subject matter in either of these cases.

(2) Claims 130, 131 are provisionally further rejected under 35 U.S.C. §101 as claiming the same invention as that of claim 14 of copending Application No. 10/692,299.

In view of the cancellation of claims 130-131 in this amendment, this rejection is moot. Thus, Applicants respectfully request that this statutory-type double patenting rejection be withdrawn.

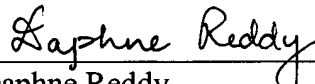
CONCLUSION

The present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641 (Attorney Docket No.: 39780-2730P1C65). Please direct any calls in connection with this application to the undersigned at the number provided below.

Respectfully submitted,

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